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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,807	06/30/2003	Kiyoshi Miyazaki	50629/DBP/A	5056

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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,807	Applicant(s) MIYAZAKI ET AL.	
	Examiner Kent L. Bell	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- application filed 6/30/03*
- 1) ☒ Responsive to ~~communication(s) filed on~~ 6/30/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/~~are~~ pending in the application.
 4a) Of the above claim(s) _____ is/~~are~~ withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/~~are~~ allowed.
- 6) ☒ Claim(s) 1 is/~~are~~ rejected.
- 7) ☐ Claim(s) _____ is/~~are~~ objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/30/03 is/~~are~~: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/6/03</u> | 6) <input type="checkbox"/> Other: _____ |

K. L. Bell

Detailed Action

Objection to the Drawing

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The submitted photographic illustrations filed June 30, 2003 are objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at: <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was

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discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical

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description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Applicants should provide a title for the application such as - -Viola Plant Named 'Sunvioki' - - (MPEP 1605, 37 CFR 1.163). The title should be placed on page 1, before line 1.

B. Page 1, line 8, Applicants state "The genus of *Viola* is *Violaceae*". This recitation appears inaccurate. The genus is *Viola*. *Violaceae* appears to be the family name. Correction and/or clarification is necessary.

C. Page 1, line 8, Applicants state "*Viola* is *Violaceae* plants". This recitation is not understood as it is unclear what applicants are intending. Correction and/or clarification is necessary.

D. Page 1, lines 25 and 28, Applicants state "parent used in the crossing of 'SUNVIOKI'". This recitation is not understood as it is unclear why 'Sunvioki' was being crossed with any cultivar. Correction and/or clarification is necessary.

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E. Page 1, lines 26 and 27, 35, and page 2, lines 5, and 16 and 17, Applicants should delete “Omi R&D Center of Suntory Flowers Ltd.” as this recitation constitutes unwarranted advertising (MPEP 1610).

F. Page 1, lines 29 and 30, Applicants should delete “Daiichi Seed Co., Ltd. (Japan)” as this recitation constitutes unwarranted advertising (MPEP 1610).

G. Page 2, lines 3 and 4, Applicants state “Those seedlings were carried out a trial”. This recitation is not understood as it is unclear what applicants are intending. Correction and/or clarification is necessary.

H. Page 2, lines 12 and 13, Applicants state the instant cultivar is “uniform and stable in its characteristics”. However, this recitation does not mean the instant plant reproduces true to type in successive generations of asexual reproduction. If the plant does reproduce true to type then applicant should also state in the specification - -The new variety reproduces true to type in successive generations of asexual reproduction.- -. Applicants could also set forth this information at page 2, line 23 after “confirmed.”. If the plant does not reproduce true to type then applicants will be unable to obtain a U.S. Plant Patent on this particular cultivar.

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I. Applicants are requested to set forth in the specification whether the parental cultivars, ‘9V-39a’ and ‘Alpine Sun’, and cultivars, ‘Alpine Spring’ and ‘Violetto Lune’, have been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

J. Page 11, line 14, Applicants states “first vegetative propagated variety”. This recitation may not be true as it is almost certain that other Viola plants have been vegetatively produced. Correction and/or clarification is necessary.

K. Page 11, lines 29-32, Applicants should set forth in the specification where the instant plant was described.

L. Page 11, lines 29-32, Applicants should set forth in the specification the age of the plant when described and container size, if grown in a container.

M. Page 12, lines 1-4, Applicants should set forth in the specification additional information relative to the instant plant’s stem including the typical and observed stem internode

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length and stem coloration with reference to the employed color chart.

N. Page 12, line 6, Applicants should delete “Overal” and insert - -Overall- -. Correction is necessary.

O. Page 12, line 19, Applicants should set forth in the specification additional information relative to the instant plant’s leaf venation including coloration with reference to the employed color chart.

P. Page 12, line 20, Applicants should set forth in the specification additional information relative to the instant plant’s petiole including the typical and observed petiole diameter and coloration with reference to the employed color chart.

Q. Page 12, line 21, Applicants should set forth in the specification additional information relative to the instant plant’s stipule including the typical and observed stipule shape, width, and coloration (both surfaces) with reference to the employed color chart.

R. Page 12, line 24, Applicants state peduncle thickness is “Thin”. Applicants should set forth in the specification the typical and observed peduncle diameter. The recitation “Thin” is

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vague and insufficient in this instance.

S. Applicants should set forth in the specification information relative to the instant plant's bud including the typical and observed amount per cluster (if present in a cluster), shape, length, diameter, and coloration with reference to the employed color chart.

T. Page 12, lines 28 and 29, Applicants should set forth in the specification additional information relative to the instant flower including flower depth.

U. Page 12, line 32, Applicants state petal number is "Single". This recitation is not understood as it appears from the photographic illustrations provided and specification page 12, line 34, and page 13, lines 3 and 9 that there are more than one single petal per flower. Correction and/or clarification is necessary. Applicants should set forth in the specification the typical and observed petal number per flower.

V. Page 12, lines 33 and 37, and page 13, lines 6 and 12, Applicants state "Flower color – Self-colored". This recitation is not understood as it is unclear what applicants are intending. Correction and/or clarification is necessary.

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W. Page 12, line 34 to page 13, line 14, Applicants should set forth in the specification additional information relative to the instant plant's petals including the typical and observed petal apex, base, and margin descriptors.

X. Page 13, lines 1, 7, and 13, Applicants set forth petal colors. However, it is uncertain whether the colorations set forth are for the petal upper or lower surface or both surfaces. Applicant should set forth in the specification color designations for the petal upper and lower surfaces with reference to the employed color chart.

Y. Page 13, line 18, Applicants should set forth in the specification additional information relative to the instant plant's spur including the typical and observed spur length, diameter, and coloration with reference to the employed color chart. The recitation "Longer than the sepal appendage" is vague and insufficient especially as applicants have not set forth any meaningful information relative to the instant plant's sepal (the recitation "short" for sepals is also vague).

Z. Page 13, line 19, Applicants should set forth in the specification additional information relative to the instant plant's sepals including the typical and observed sepal number, shape, length, width, apex and margin descriptor, and coloration (both surfaces) with reference to the employed color chart. The recitation "Sepal – Short" is vague and insufficient in this instance.

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AA. Page 13, line 20, Applicants state there are “Many” flowers. Applicants should set forth in the specification the typical and observed number of flowers present on a plant at one time.

AB. Page 13, lines 21 and 22, Applicants should set forth in the specification additional information relative to the instant plant’s seed including the typical and observed seed number, shape, size, and coloration with reference to the employed color chart. The recitation “Color – Deep brown” is vague and insufficient in this instance.

AC. Page 13, line 24, Applicants should set forth in the specification the typical and observed flowering time. The recitation “Early” is vague and insufficient in this instance.

AD. Applicants should set forth in the specification the time it takes to produce a flowering plant.

AE. Applicants should set forth in the specification the lastingness of an individual bloom, on the plant.

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AF. Page 13, lines 28 and 29, Applicants should set forth in the specification information relative to the instant plant's winter hardiness. The recitation "Cold – Strong" is vague and insufficient in this instance.

AG. Page 13, lines 30 and 31, Applicants state Resistance to disease and pest is "Strong". Applicant should set forth in the specification meaningful information relative to the instant plant's Resistance to diseases and pests such as stating which disease and pests the instant plant is resistant or susceptible to. The recitation "Strong" is vague and insufficient in this regard.

AH. If produced, information relative to the instant plant's pedicel should be set forth in the specification including the typical and observed pedicel length, diameter, and coloration with reference to the employed color chart.

AI. Page 14, line 10, Applicants state "self-colored" flower. This recitation is not understood as it is unclear what applicants are intending. Correction and/or clarification is necessary.

AJ. Throughout the specification, The Claim, and the Abstract, Applicants should review the entire application for proper sentence structure and grammatical errors. There are many

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places throughout the specification that are confusingly written and do not make sense.

Correction is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Applicants should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Applicants should send all correspondence to the following address:

Serial Number: 10/611,807
Art Unit: 1661

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COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (571) 272-1600.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

Kent L. Bell